

REMARKS

Summary of the Response

Upon consideration of the present response, claims 1 – 42 will remain pending and under consideration by the Examiner.

Summary of the Office Action

In the instant Office Action, the Examiner has rejected claim 1 based upon a formal matter and has rejected claims 1 – 42 over the art of record. By the present amendment and remarks, Applicants submit that the objections and rejections have been overcome, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application.

Traversal of Rejection Under 35 U.S.C. § 112, Second Paragraph

Applicants traverse the formal rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner asserts it is unclear how the information file can include a GIF request.

Applicants note that 35 U.S.C. § 112, second paragraph, requires that the "specification conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which [Applicants] regard as [their] invention." 35 U.S.C. § 112, *Patent, Trademark and Copyright Laws 2003*, Patent Publishing, LLC (2003). Thus, while the second paragraph of 35 U.S.C. § 112 is concerned with the manner and clarity of the recitation of the invention, so as to define the subject matter of the invention, there is no requirement that the claims specifically define "how" the invention operates or how it can include an a specific element.

In contrast to this requirement of the claims, Applicants note that it is the purpose of

the specification to provide "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the [inventors] of carrying out [their] invention." 35 U.S.C. § 112, *Patent, Trademark and Copyright Laws 2003*, Patent Publishing, LLC (2003). Thus, in contrast to the claims, which define the subject matter of the invention, the specification provides the full disclosure to enable those skilled in the art to make and use the invention.

Because the Examiner has rejected independent claim 1 under 35 U.S.C. § 112, second paragraph, Applicants understand the instant rejection to be directed to the clarity of the claim at issue and not questioning the disclosure.

As Applicants' original disclosure sets forth, e.g., in the first paragraph on page 11,

[i]n order to gather the exact number of hits on a specific page, e.g., an advertisement, a *small image object* can be added to the page with the *object set to expire immediately*, so the caching server won't cache the object. Then, every time a user requests that page, the browser or caching server will retrieve the object from the original web server, and the web server can then count the exact number of requests.

[emphasis added]. Moreover, the original disclosure provides that this small image object can be a single pixel GIF implemented as shown in Fig. 2.

Accordingly, Applicants submit that one ordinarily skilled in the art, after reviewing the specification and claims, would readily understand the meaning of the phrase "the information file further including an uncacheable single pixel Graphics Image Format (GIF) request," as recited in independent claim 1, as well as the scope of independent claim 1 that recites this phrase.

Therefore, Applicants submit that, as independent claim 1, as well as claims 2 – 42,

clearly and unambiguously recites the subject matter that Applicants regard as their invention, the pending claims are fully in compliance with the requirements of the statute. Accordingly, Applicants request that the Examiner reconsider and withdraw the formal rejection of independent claim 1 under 35 U.S.C. § 112, second paragraph, and acknowledge that the pending claims are in compliance with the statute.

Traversal of Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1 – 42 under 35 U.S.C. §103 (a) as being unpatentable over CHLAN et al. (U.S. Patent No. 6,385,642) [hereinafter "CHLAN"] in view of HAWES (U.S. Patent No. 6,094,662). The Examiner asserts that CHLAN shows the recited features of the invention, with the exception of a single pixel GIF request, and that it would have been obvious to modify CHLAN to include such a non-cacheable GIF in view of HAWES teaching of an apparatus for loading and unloading HTML pages having cacheable and non-cacheable portions including a single pixel GIF request. Applicants traverse the Examiner's assertions.

Applicants' independent claim 1 recites, *inter alia*, a server network element including server software and a database for generating and storing a plurality of information files that are accessible to a requesting network element, the information files including text files and key words that are interpreted by the requesting network element to display the information requested, the information file further including *an uncacheable single pixel Graphics Image Format (GIF) request*, wherein upon interpreting the information file, the single pixel GIF request is transmitted from the requesting element over the communications network to the server network element which reads and stores enriched data contained therein. Applicants' independent claim 17 recites, *inter alia*,

generating and storing a plurality of information files at a server network element that are accessible to a requesting network element, the information files including text files and key words and a *single pixel Graphics Image Format (GIF) request*, transmitting the single pixel GIF request from the requesting element over the communications network to the server network element, and reading and storing the enriched activity data contained in the transmitted single pixel GIF request at the server network element. Further, Applicants' independent claim 32 recites, *inter alia*, program instructions that generate and store a plurality of accessible information files at a server network element, the information files including text files and key words and a *single pixel Graphics Image Format (GIF)*, program instructions that receive the single pixel GIF request from the requesting element when the requesting element interprets the contents of the information file, and program instructions that read and store the enriched activity data contained in the transmitted single pixel GIF request at the server network element.

Applicants acknowledge and agree with the Examiner that CHLAN fails to teach or suggest an information file including an uncacheable single pixel GIF request, as recited in at least independent claim 1.

However, Applicants find inconsistency in the Examiner's consideration and treatment of HAWES resulting in flawed rationale in rejecting at least independent claim 1. In particular, Applicants note that, while the Examiner's rejection does not point to any disclosure in HAWES of an *uncacheable* single pixel GIF request (in fact, the Examiner has not even asserted HAWES discloses an uncacheable single pixel GIF request), the Examiner ultimately concludes it would have been obvious to modify CHLAN to include a non-cacheable GIF.

Applicants note that, as HAWES discloses "in the general case, the non-HTML portions, such as GIF's, or bitmaps or other image portions are stored as cacheable information," while HTML portions of the web page "are stored as non-cacheable information," HAWES fails to provide any arguable teaching or suggestion of utilizing an uncacheable single pixel GIF.

Further, as the Examiner has not pointed to any specific teaching of an uncacheable single pixel GIF request disclosed in HAWES, as recited in at least independent claim 1, Applicants submit this document fails to cure the deficiencies of CHLAN identified by the Examiner in the pending rejection, such that no proper combination of these document can render the present invention obvious.

Because neither applied document teaches or suggests at least the above-noted feature of the present invention, Applicants submit that no proper combination of these documents can even arguably render unpatentable the combination of features recited in at least independent claim 1.

Moreover, while Applicants acknowledge that HAWES discloses the use of GIFs, this document fails to provide any teaching or suggestion of utilizing a single pixel GIF and/or a single pixel GIF request, as recited in at least independent claims 1, 17, and 32.

Further, Applicants note that neither CHLAN nor HAWES provides any teaching or suggestion of a GIF request will be transmitted to read and store the enriched activity data contained in the transmitted GIF request at the server network element, and certainly no teaching or suggestion of a single pixel GIF request will be transmitted to read and store the enriched activity data contained in the transmitted single pixel GIF request at the server network element, as recited in at least independent claim 17.

Similarly, Applicants submit that neither CHLAN nor HAWES provides any teaching or suggestion of program instructions that receive the GIF request from the requesting element when the requesting element interprets the contents of the information file, and program instructions that read and store the enriched activity data contained in the transmitted GIF request at the server network element, and certainly fails to teach or suggest program instructions that receive the single pixel GIF request from the requesting element when the requesting element interprets the contents of the information file, and program instructions that read and store the enriched activity data contained in the transmitted single pixel GIF request at the server network element, as recited in at least independent claim 32.

Because neither CHLAN nor HAWES provide any teaching or suggestion for at least the above-noted features of the present invention, Applicants submit that no proper combination of these documents can even arguably render unpatentable the combination of features recited in at least independent claims 17 and 32.

Further, Applicant submits that claims 2 – 16, 18 – 31, and 33 – 42 are allowable at least for the reason that these claims depend from allowable base claims and because these claims recite additional features that further define the present invention. In particular, Applicant submits that no proper combination of CHLAN and HAWES teaches or suggests the combination of features recited in the above-noted claims.

Thus, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of the claims 1-42.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the

Serial No.: 09/641,495
Attorney Docket No.: P26903.A05.doc

claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to IBM Deposit Account No. 09-0547 (Endicott).

Respectfully submitted,
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